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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,693	12/22/2005	Leif Brunstrom	SSTRP0102US	2025
58342 7590 03/21/2008 WARREN A. SKLAR (SOER) RENNER, OTTO, BOISSELLE & SKLAR, LLP 1621 EUCLID AVENUE 19TH FLOOR CLEVELAND, OH 44115				
EXAMINER HERNANDEZ, NELSON D				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/529,693

Applicant(s)

BRUNSTROM ET AL.

Examiner

Nelson D. Hernández

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 9-13 is/are rejected.
- 7) ☒ Claim(s) 4-8, 14 and 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/003)
Paper No(s)/Mail Date 3/28/05, 10/16/06 & 7/12/07
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Objections

2. **Claims 4-8** are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent **claim 3**. See MPEP § 608.01(n). Accordingly, the **claims 4-8** have not been further treated on the merits.
3. **Claims 14 and 15** are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent **claim 11**. See MPEP § 608.01(n). Accordingly, the **claims 14 and 15** have not been further treated on the merits.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. **Claim 3** is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 3, which depends from any of claims 1 or 2, recites that the optical arrangement comprises a mirror. According to the Specifications, the arrangement may comprise a prism as shown in figs. 2a and 2b, and also may comprise a mirror as shown in figs. 3a and 3b instead of the prism but. Therefore, although claim 3, if read according to claim 1 would enable one skilled in the art to make and/or use the invention, claim 3 according to claim 2 would not allow one skilled in the art to make and/or use the invention since the Specifications does not disclose the use of both a prism and a mirror in the same embodiment. Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 9 is rejected under 35 U.S.C. 102(b) as being anticipated by Nishino et al., US 2001/0005454 A1.

Regarding claim 9, Nishino et al. discloses a portable communication apparatus (Figs. 9 and 10A-10B) comprising: a first housing portion (Fig. 10A: 1Y) and a second housing portion (Fig. 10A: 1X), a rotary support member (Fig. 10A: 1Z) rotatably connecting the first housing portion and the second housing portion, an image producing apparatus (Fig. 9: 14), and an optical input (Fig. 9: 2) for the image producing apparatus located in the support member (See fig. 10A: 2), characterized in that the connection between the first

housing portion (1Y) and the rotary support member (1Z) is fixed (the rotary support 1d as shown in fig. 10B is fixed to the first housing 1X; see page 6, ¶ 0084), wherein the optical input (lens 2 as shown in fig. 10A) of the image producing apparatus (14) is rotatably fixed relative to the first housing portion (as shown in fig. 10, the optical input is part of the hinge portion 1Z which is rotatably fixed to the first housing ("case", 1Y). Therefore, the optical input is rotatably fixed with respect to the first housing.) (Page 6, 0083-0088).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Umezawa et al., US Patent 5,491,507 in view of Nagata et al., US 2002/0067426 A1.**

Regarding claim 1, Umezawa et al. discloses a portable communication apparatus (See fig. 13) comprising: a first housing portion (Fig. 13: 49) and a second housing portion (Fig. 13: 50), a rotary support member (Fig. 1: hinges 51a and 51b) rotatably connecting the first housing portion and the second housing portion (See fig. 13), an image producing apparatus (Fig. 13: 61), an optical input for the image producing apparatus located in the support member (the complete camera system is located in the rotary support member; see figs. 13, 15 and 16) (Col. 14, line 62 – col. 15, line 51).

Umezawa et al. does not explicitly disclose that the image producing apparatus is located in the first housing portion or the second housing portion of the portable communication apparatus, and an optical arrangement extends an optical path of the image producing apparatus from the first housing portion or the second housing portion to the optical input located in the rotary support member.

However, Nagata et al. discloses an electronic camera (See fig. 1, 2 and 22) comprising a body (body 2 as shown in fig. 1, 2 and 22); an image sensor (fig. 2: 17; fig. 22: 233) in the body of the camera; and a rotary member (Fig. 2: 12 and fig. 2: 208) connected to the body, said rotary member comprising a lens (6 and 7 as shown in fig. 2) and a prism (Fig. 2: 8) to extend an optical path of the image producing apparatus from the body to the optical input (lens 6 or 7) located in the rotary member (Page 1, ¶ 0007; page 2, ¶ 0045; page 3, ¶ 0046-0047; page 7, ¶ 0081-0085).

Therefore, after acknowledging the advantages in Nagata et al. where the optical arrangement would allow a considerable size reduction of the image pick-up apparatus, one of an ordinary skill in the art would find obvious at the time the invention was made to modify the teaching of Umezawa et al. to have the image producing apparatus located in the first housing portion or in the second housing portion of the portable communication apparatus, and to have the optical arrangement to extend an optical path of the image producing apparatus from the first housing portion or the second housing portion to the optical input located in the rotary support member. The motivation to do so would have been to reduce the size of the apparatus as suggested by Nagata et al. (Page 1, ¶ 0006).

Regarding claim 2, limitations have been discussed and analyzed in claim 1.

Regarding claim 3, the combined teaching of Umezawa et al. in view of Nagata et al. as discussed and analyzed in claim 3 teach that the optical arrangement comprises a mirror (See Nagata et al., fig. 23, 107 as shown in an alternative embodiment). Grounds for rejecting claim 1 apply here.

10. Claims 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishino et al., US 2001/0005454 A1 in view of Nagata et al., US 2002/0067426 A1.

Regarding claim 10, Nishino et al. does not explicitly disclose that the image producing apparatus is located in the first housing portion.

However, Nagata et al. discloses an electronic camera (See fig. 1, 2 and 22) comprising a body (body 2 as shown in fig. 1, 2 and 22); an image sensor (fig. 2: 17; fig. 22: 233) in the body of the camera; and a rotary member (Fig. 2: 12 and fig. 2: 208) connected to the body, said rotary member comprising a lens (6 and 7 as shown in fig. 2) and a prism (Fig. 2: 8) to extend an optical path of the image producing apparatus from the body to the optical input (lens 6 or 7) located in the rotary member (Page 1, ¶ 0007; page 2, ¶ 0045; page 3, ¶ 0046-0047; page 7, ¶ 0081-0085).

Therefore, after acknowledging the advantages in Nagata et al. where the optical arrangement would allow a considerable size reduction of the image pick-up apparatus, one of an ordinary skill in the art would find obvious at the time the invention was made to modify the teaching of Nishino et al. to have the image producing apparatus located in the first housing portion or in the second housing portion of the portable communication

apparatus, and to have the optical arrangement to extend an optical path of the image producing apparatus from the first housing portion or the second housing portion to the optical input located in the rotary support member. The motivation to do so would have been to reduce the size of the apparatus as suggested by Nagata et al. (Page 1, ¶ 0006).

Regarding claim 11, limitations have been discussed and analyzed in claim 10.

Regarding claim 12, limitations have been discussed and analyzed in claim 10.

Regarding claim 13, the combined teaching of Nishino et al. in view of Nagata et al. as discussed and analyzed in claim 3 teach that the optical arrangement comprises a mirror (See Nagata et al., fig. 23, 107 as shown in an alternative embodiment). Grounds for rejecting claim 1 apply here.

Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nelson D. Hernández whose telephone number is (571)272-7311. The examiner can normally be reached on 9:00 A.M. to 5:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lin Ye can be reached on (571) 272-7372. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nelson D. Hernández
Examiner
Art Unit 2622

NDHH
March 7, 2008

/Lin Ye/
Supervisory Patent Examiner, Art Unit 2622